

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re application of | : | |
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| URS (NMI) REUTELER ET AL. | : | Confirmation No.: 5960 |
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| Serial No.: 10/532,528 | : | Group Art Unit: 3721 |
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| National Stage of PCT/US03/034067 | : | Examining Attorney: Christopher Harmon |
| | : | |
| Filed: October 7, 2005 | : | |
| | : | |
| For: | : | CARTON FEEDING AND FORMING MACHINE WITH SELECTIVELY ACTUATED LUGS AND RELATED METHODS |

RESPONSE TO RESTRICTION REQUEST

Dear Sir:

In response to the Office Action dated March 14, 2007, Applicant pursuant to 37 CFR 1.143 hereby elects the invention of Examiner-identified Group I, claims 1-9 and requests the wholesale withdrawal of the requirement for restriction.

As a primary basis for the request for withdrawal, Applicant submits that the Examiner's findings do not meet the requirements of PCT Rules 13.1 and 13.2, as well as 37 CFR 1.475 ("Rule 1.475"), which provides:

Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled *only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features*. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. . . .

(emphasis added). As is plain from the foregoing, a proper request for restriction involves an examination of whether a "technical relationship" exists "among those inventions *involving one or more of the same or corresponding technical features*" (emphasis added). However, the test applied in the Office Action examines whether the inventions *lack* the

same or corresponding technical features because “each has at least one special technical feature unique to it and not requiring the feature of another group.” (Office Action dated March 14, 2007, p. 1, paragraph 1). These “technical features” are then recited as merely comprising a myriad of elements of the various claimed inventions of the different groups - “means for folding and two conveyors, rotatable wheel and one conveyor; sealing first and third flaps.”

Respectfully, this is an incorrect interpretation of the plain language of the applicable rules and otherwise not in accordance with law. The requirement set forth in Rule 1.475 looks not at whether a particular claimed invention has “at least one” special technical feature “unique” to its own group. Rather, the proper focus is whether one or more of the same or *corresponding* features are *in common*.¹ “Additional” unique features do not necessarily result in a lack of unity of invention (such as, for instance, in the combination and subcombination situation, where both inventions may have a technical feature in common yet the combination may include a unique one as well). Moreover, the fact that certain claims may define inventions to include one or more parts not found in the others is not the proper consideration (such as, for instance, in the genus/species situation, where species ABC and ABCD may not lack “unity of invention” with the genus AB, even though each potentially has at least one special technical feature “unique” to its own group; namely, C and D). Accordingly, an overall challenge to the holding is made with respect to the finding that unity of invention is lacking with respect to all claims present, since the test applied is not in accordance with the law.

Moreover, according to Annex B to Rule 13.1 of the PCT Administrative Instructions and 37 CFR Sections, “unity of invention” remains present even when: (1) independent

¹ See Request for Comments on the Study of the Changes Needed To Implement a Unity of Invention Standard in the United States, 68 Fed. Reg. 27536 (2003) (“As long as the same or *corresponding common feature is found in each claim* and that common feature makes a contribution over the prior art, *the claims comply with the requirement for Unity of Invention*”) (emphasis added).

claims are directed to both a process and an apparatus or means “*specifically designed for carrying out*” the process; or (2) independent claims for a process for the manufacture of a product for an apparatus or means “*specifically designed for carrying out*” the process. This Annex also elucidates the foregoing standard by providing that “an apparatus or means shall be considered to be ‘*specifically designed for carrying out*’ a claimed process if the contribution over the prior art of the apparatus or means *corresponds to* the contribution the process makes over the prior art” (emphasis added). Furthermore, the Annex emphasizes that the “expression ‘specifically designed’ *does not* imply that the apparatus or means could not be used for carrying out another process, nor that the process could not be carried out using an alternative apparatus or means” (emphasis added). The requirement of “unity of invention” is thus not in accord with the PTO rule for restriction applied in regular applications, which indeed looks at whether a claimed apparatus or means can be used for practicing a materially different process, or vice versa. *See Caterpillar Tractor Co. v. Commissioner of Patents & Trademarks*, 650 F. Supp. 218 (E.D. Va. 1986) (noting differences between standards and rejecting PTO interpretation of PCT Rule 13 in accordance with its own restriction rules).²

A more specific ground of objection is made with respect to the alleged lack of unity of the Group I and Group III inventions. The corresponding claims are directed to a machine (apparatus) for conveying a carton (product) in two orthogonal directions with folding of a flap and a method (process) for completing a carton (product) with conveying in two orthogonal directions with a folded flap. At least one special technical feature common to both groups is conveying a carton in orthogonal directions with at least one folded flap, and

² *See also* Request for Comments on the Study of the Changes Needed To Implement a Unity of Invention Standard in the United States, 68 Fed. Reg. 27536 (2003) (“Some examples of related inventions that are often filed together and typically can be restricted under current United States practice before a prior art search is conducted, but do not lack unity under the Unity of Invention standard, include: (1) *A process, and the apparatus for carrying out the process*; (2) *a process for making a product, and the product made*; (3) *an apparatus, and the product made by the apparatus*; (4) *a product, and the process of using the product*”) (emphasis added).

it is not fatal that the process of Group III can be performed using an apparatus different from that claimed in Group I or whether the apparatus of Group I can be used to perform a process different from the one claimed in Group III (or whether each set of claims includes an invention with at least one special technical feature unique to its own group). Rather, commonality of at least one “special technical feature” is what is required (and the features need not be identical, only “corresponding”). Accordingly, even if the Examiner maintains the restriction request with regard to the Group II claims, the Group I and Group III claims should be concurrently examined and not subject to restriction for this additional reason.

Finally, in all situations requiring restriction, the Examiner must show a substantial burden to warrant restriction. MPEP §808.02 (8th ed. May 2004). No factual findings in support of such a showing have been made. For example, no patents are cited indicating separate status of the Group I-III inventions in the art or the need for a different field of search. MPEP §808.02(B). Therefore, Applicant respectfully requests that the Examiner identify the nature of the serious burden in examining claims 1-9, 10-19, 83-88, and 89-92, or else withdraw the restriction request.

In light of the foregoing, Applicant respectfully requests withdrawal of the restriction request and examination of all pending claims. Any fees due may be debited from Deposit Account 11-0978.

Respectfully submitted,
KING & SCHICKLI, PLLC

A handwritten signature in black ink, appearing to read 'Andrew D. Dorisio', is written over the firm name.

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